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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,403	10/21/2003	Hiroki Moriyama	17137	5951
23389	7590	09/25/2007	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			REKSTAD, ERICK J	
400 GARDEN CITY PLAZA			ART UNIT	PAPER NUMBER
SUITE 300			2621	
GARDEN CITY, NY 11530				
MAIL DATE		DELIVERY MODE		
09/25/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/690,403	MORIYAMA, HIROKI
Examiner	Art Unit	
Erick Rekstad	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 June 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7, 10, 11, 14, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7, 10, 11, 14, 16 and 18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

This is a Final Rejection for Application no. 10/690,403 in response to the Amendment filed on June 25, 2007.

Response to Arguments

Applicant's arguments filed June 25, 2007 have been fully considered but they are not persuasive.

The Applicant argues the combination of US Patent 5,885,208 to Moriyama with US Patent 4,690,175 to Ouchi et al. Applicant specifically states "the Examiner's stated reasoning as to why the skilled artisan would make such a proposed combination fails to establish a *prima facie* case of obviousness. Moreover, applicant's claim language is not so broad as to merely set forth an endoscope with varying flexibility, so the Examiner's reasoning fails to address the scope and content of the prior art, rendering the asserted combination improper under Section 103(a) and KSR." The Examiner respectfully disagrees.

As shown in the rejection for claim 1, Moriyama teaches the use of multiple endoscopes which share the same light source unit or video processor (Fig. 10). Moriyama further teaches the endoscopes having soft sections (13, 213, 313, 413) which have different softness characteristics (Figs. 23, 24, 26, 27, 29-33). As an example, Figure 23 depicts an endoscope with an overall soft section (512A). This soft section's characteristics are determined using armor tubes (531a and 531b). These tubes exhibit different hardness levels (Col 26 Line 57-Col 27 Line 8). Thus, Moriyama teaches the use of tubes. Moriyama is silent on the tubes causing different diameters.

Ouchi teaches the prior art for such a tubing used by Moriyama. Ouchi further teaches how the tubes are used to produce different hardness characteristics (Abstract, Col 7 Lines 13-35). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use the tubing of Ouchi with the endoscope of Moriyama in order to provide the flexible characteristics required by Moriyama.

In regards to Applicant's arguments related to the teaching of the limitation of claim 1 by Moriyama and Ouchi, the Applicant states that Moriyama does not teach different diameter soft sections and Ouchi's flexible tubes does not suggest the limitations of claim 1. The Examiner respectfully disagrees.

As noted by the Applicant, Moriyama asserts that endoscope 402 has a larger diameter than that of endoscope 302. Specifically, Moriyama states the insertion unit (306) of endoscope 302 has a small diameter while the insertion unit (406) has a large diameter (Col 19 Lines 40-41 and 45-47). The insertion units are composed of a distal part, bending portions and soft parts (213, 313, and 413) (Col 19 Lines 25-29). Therefore, if the insertion units have a specific diameter the soft part has the same diameter since one of the components of the insertion unit is the soft part.

Thus, Moriyama alone teaches the second and third endoscopes. The combination of Moriyama and Ouchi teaches the requirements of the first endoscope.

In regards to the Applicant's arguments related to claims 2-20, the Applicant relies on the arguments provided for claim 1. Therefore, the arguments have been responded to as shown above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,885,208 to Moriyama in view of US Patent 4,690,175 to Ouchi et al.

[claim 1]

As shown in Figure 10, Moriyama teaches the use of multiple sized endoscopes (7, 207, 307, 407). The endoscopes each share the video processor (4) and light source (3)(Col 19 Lines 13-16). Moriyama further teaches the soft portion (13, 213, 313, 413) are part of the insertion units (6, 206, 306, 406) of the endoscopes (Col 19 Lines 25-29). Moriyama teaches the insertion units have different diameters (Col 19 Lines 40-41 and 45-47). It would be inherent that the soft portions would have different diameters since they are part of the insertion units. Note, the citation specifically states endoscope 402 has a large diameter insertion unit (406) and endoscope 302 has a small diameter insertion unit (305). It is further noted by the Examiner that Figure 10 depicts endoscopes 7, 207, and 307 all having the same diameter insertion units. These endoscopes satisfy the requirements for the second and third endoscope in claim 1. Moriyama further teaches the use of varying softness for the endoscopes (Figs. 23, 24, 26, 27, 29-33). Figure 23 depicts an endoscope with an overall soft section (512A). This soft section's characteristics are determined using armor tubes (531a and 531b).

These tubes exhibit different hardness levels (Col 26 Line 57-Col 27 Line 8). Moriyama is silent of the use of a small diameter and a large diameter for the outer diameter for any of the soft portion (13, 213, 313, 413) as required by the first endoscope in claim 1.

Ouchi teaches the use of flexible tubes for use with endoscopes to vary the flexibility of the endoscope tube (Abstract). Ouchi specifically teaches the use of a small-diameter(A) and a large diameter(B) in order to vary the flexibility (Fig. 1 and 5, Col 7 Lines 13-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide an endoscope using the flexible tubing of Ouchi with the endoscope system of Moriyama in order to provide an endoscope with varying flexibility as taught by Ouchi (Abstract).

[claims 2-7, 10, 11, 14-16 and 18]

As shown in Figure 10, Moriyama shows endoscopes (7, 207, and 307) having different diameters and lengths of insertion units (2, 202, 302). Moriyama further suggest different softness characteristics for different endoscopes (Figs. 23, 24, 26, 27, 29-33). Ouchi teaches the use of different tubes for varying flexibility (Abstract, Fig. 2). Ouchi further teaches the tubes cause different diameters (Figs 1 and 5, Col 7 Lines 13-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to use different designs for the endoscope tubes in order to provided desired flexibility in the endoscope system of Moriyama as taught by Ouchi (Abstract, Figs. 1, 2 and 5).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erick Rekstad whose telephone number is 571-272-7338. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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